REMARKS/ARGUMENTS

In the Office Action, the Examiner has rejected the claims under 35 U.S.C. 101, 35 U.S.C. 112 and U.S.C. 102.

Solely in order to expedite prosecution, claims have been presented in a form that is believed to be preferred by the Examiner. In addition, claim 2 has been cancelled to expedite prosecution. it is respectfully requested that Examiner withdraw the rejections under 35 U.S.C. 101 and 35 U.S.C. 112, and cancel claim 2 without disclaimer or prejudice.

The Examiner has rejected claims 1-20 under 35 U.S.C. 102(e) as being anticipated under U.S. patent No. 6,349,337 (*Lindwer*). This rejection is fully traversed below.

Rejections of claims under 35 U.S.C. 102

The present application relates to a set of inventive virtual machine instructions can effectively represent the complete set of operations performed by a conventional Java Bytecode instruction set. As will be appreciated, the operations performed by conventional instructions can be performed by relatively fewer inventive virtual machine instructions. This allows implementation of relatively simpler interpreters and allows for alternative use of the limited 256 (2^8) conventional Bytecode representation. As a result, the performance of virtual machines, especially, those operating in systems with limited resources, can be improved. (see, for example, summary of the invention).

As a representative claim, claim 1 pertains to a computer readable medium for storing a set of virtual machine instructions suitable for execution in a virtual machine. The set of virtual machine instructions represent a number of corresponding Java Bytecode executable instructions that are also suitable for execution in the virtual machine. It should be noted that the set of the virtual machine instructions consists of a number of virtual machine instructions which is less than the number of the corresponding Java Bytecode executable instructions. In addition, every one of the

corresponding Java Bytecode executable instructions can be represented by at least one of the virtual machine instructions in the virtual machine instruction set (claim 1).

Contrary to the Examiner's assertion (Office Action, page 5, paragraph 11), it is respectfully submitted that *Lindwer* does NOT teach a set of virtual machine instructions consisting of a number of virtual machine instructions which is less than the number of the corresponding Java Bytecode executable instructions. It is noted that *Lindwer* states that a program can be more compactly expressed in virtual machine instructions than in the native instructions (*Lindwer,* Col. 1, lines 53-56*)*. However, it is respectfully submitted that expressing a program in virtual machine instructions does Not teach or even remotely suggest a set of virtual machine instructions consisting of a number of virtual machine instructions which is less than the number of the corresponding Java Bytecode executable instructions. Accordingly, it is respectfully submitted that claim 1 and its dependent claims are patentable over *Lindwer* for at least this reason alone. In addition, claim 10 and its dependent claims are over *Lindwer* because they recite similar features.

Independent claim 13 pertains to a computer readable medium for storing a set Java Bytecode instruction translator which operates to convert a set of Java Bytecode executable instructions suitable for execution on a virtual machine into a set of corresponding executable virtual machine instructions. It should be noted that the corresponding set of the virtual machine instructions consists of a number of virtual machine instructions that is less than the number of the corresponding Java Bytecode executable instructions (claim 13).

It is noted that *Lindwer* states that a virtual machine instruction can be converted to a sequence of native instructions (*Lindwer,* Col. 6, 50-51*)*. However, contrary to the Examiner's assertion (Office Action, page 8, paragraph 11), it is respectfully submitted that *Lindwer* does NOT teach or suggest that the corresponding set of the virtual machine instructions consists of a number of virtual machine instructions that is less than the number of the corresponding Java Bytecode executable instructions. Accordingly, it is respectfully submitted that claim 13 and its dependent claims are patentable over *Lindwer* for at least this reason alone.

Rejections of claims under 35 U.S.C. 112

In the Office Action, the Examiner has rejected the claims 35 U.S.C. sections 112, second paragraph for reciting the trademark name Java.

It is noted that the Board of Appeals has held that a patent applicant has an obligation that is imposed by 35 U.S.C. 112, second paragraph, to employ claim terminology which is definitive of what the public is not free to use, and use of a trademark may result in claims which fail to meet this obligation. *Ex parte Simpson and Roberts*, 218 USPQ 1021-22 (Bd. Pat. App. & Int. 1982). However, the Board of Appeals decision to the effect that a product on the market should be known generally to those skilled in the art or it should be necessary to use a trade name should also be noted; *Ex parte Frederick and Waterfall*, 75 USPQ 298 (Bd. Pat. App. & Int. 1947)).

It is respectfully submitted that the undersigned earnestly believes that there is no legal requirement that use of a trademark name in claims renders a claim indefinite per se. Moreover, it is respectfully submitted the Java programming language similar to other programming languages (e.g., the C programming language) is well known to those skilled in the art by a trademark name. In fact, Java programming language is primarily known to those skilled in the art by its trademark name. As such, it is necessary to use the trademark name Java in some instances in order to define the scope of the invention. Accordingly, it respectfully submitted that appropriate use of the trademark name Java does not render the claims indefinite because Java programming language is both well known in the art and it is necessary to use the trademark name Java in some instances to employ claims terminology that is definite.

Conclusion

Based on the foregoing, it is submitted that claims are patentably distinct over the cited art of record. Additional limitations recited in the independent claims or the dependent claims are not further discussed because the limitations discussed above are sufficient to distinguish the claimed invention from the cited art. Accordingly, Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any

further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 500388 (Order No. SUN1P811). Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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